

Remarks

This Amendment is in response to the Final Office Action dated August 18, 2003. New claim 25 has been added which is based on claim 1 with further details concerning the bore formed in the bone.

Rejection based on 35 USC § 102

All of the claims in the application have been rejected as being anticipated under 35 USC § 102 (b) by US Patent 5,571,189 to Kuslich, the inventor of the current application. Specifically, it is stated in the rejection that when the “prior art device is the same as the device described in the specification for carrying the claimed method, it can be assumed that the device will inherently perform the claimed method.” The cited case, *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986) does **not** support this rejection. The *King* case notes that that invention was neither to methods of manufacture nor method use claims. Rather, in *King* they appeared to be a description of what happens when the structure is placed in ambient light (a prism).

Here, the claims are methods of using a bag that can be similar to the previously patented bag but the method steps are very different from the prior patent. Contrary to the Office Action’s statements, the prior art does not teach forming a cavity in bone or of any way in treating a bone abnormality. Rather, the prior Kuslich patent teaches a method for boring out a disc (which is not bone) and placing a fabric bag within the reamed out disc space. Here, bone itself is reamed out and the bag is placed within the bone cavity and filled to treat the bone abnormality.

The second case relied upon, *In re Best*, 562 F.2d 1255, 195 USPQ 430 (CCPA 1977) also fails to support a rejection of claims in this application. In that case, they discuss inherent

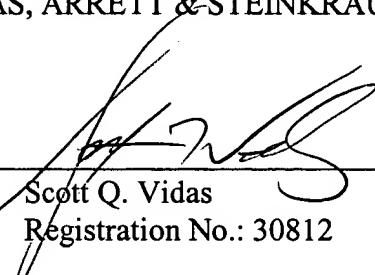
functions or properties of the composition which was inherently created by the normal cool-down of the chemical process for forming it. In the current application what is inherent about an empty fabric bag, that it could be placed somewhere, that it could be filled? This is not simply a new use for an old product. There is no product being claimed with a use clause in a preamble. Rather, this application includes full method of treatment claims with multiple process steps in treating bone disorders, something which was not discussed or suggested by the prior reference.

The rejection of the claims as anticipated by inherency is unsupported in law and must be withdrawn. Also, any attempt to characterize the inherency rejection into an obviousness rejection would likewise be unsupported. Withdrawal of the rejection and a notice of allowance is requested.

Respectfully submitted,

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